



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,026	09/24/2003	Bruce Karsh	50269-0562	7849
73066	7590	09/21/2007	EXAMINER	
Hickman Palmero Truong & Becker LLP/ Yahoo! Inc. 2055 Gateway Place Suite 550 San Jose, CA 95110-1089			FRISBY, KESHA	
		ART UNIT	PAPER NUMBER	
		3714		
		MAIL DATE	DELIVERY MODE	
		09/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HICKMAN PAPERMO TRUONG & BECKER, LLP/
Yahoo! Inc.
2055 Gateway Place
Suite 550
San Jose, CA 95110-1089

8/21/07

In re Application of :
Karsh, Bruce, et al. :
Serial No.: 10/671,026 :
Filed: September 24, 2003 : DECISION ON PETITION
Docket: 50269-0562 :
Title: VISIBLY DISTINGUISHING PORTIONS :
OF COMPOUND WORDS :

This is a decision on the petition filed on January 10, 2007 under 37 CFR § 1.181.
Petitioner requests withdrawal of abandonment.

The petition is granted.

Background

Applicants submitted an application for patent on September 24, 2003. The application included, *inter alia*, a declaration under 37 CFR § 1.63 and a Utility Patent Application Transmittal form. The declaration provides the following correspondence address:

HICKMAN PAPERMO TRUONG & BECKER, LLP
1600 Willow Street
San Jose, California 95125-5106

The transmittal includes a Customer Number, 29989. A review of the Table of Contents of the file indicates that a notice of the association of this customer number to 1600 Willow Street was to be communicated by the U.S.P.T.O. (Office) via an Office form dated on the Contents line December 23, 2004 and listed on the Contents as "Change of Address". However, there is no date stamp on the form to indicate it was actually mailed to applicants' legal representative. Another line on the Contents with "Change of Address" and dated January 11, 2005 includes the same Office form on a second page of the line with "12-23-04" handwritten on it but this also does not evidence a formal mailing from the Office.

An Office action by the assigned examiner was mailed May 09, 2006 but was returned to the Office as undelivered on May 19, 2006. Page 37 of the contents of the return mailing includes a copy of the envelope which has a label presumably from the U.S. Postal Service and which states:

FORWARD TIME EXP RTN TO SEND
HICKMAN PAPERMO TRUONG & BECKER, LLP
2055 OLTEWAY PL STE 550
SAN JOSE, CA 95110-1083

On August 22, 2006, applicants filed a status inquiry with the new address but did not provide the Customer Number and a change of address. However, on December 04, 2006 a Power of Attorney was filed which included the Custom Number. The NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY (comprising page 2 of the Contents line set forth as "Communication-Re: Power of Attorney (PTOL-308)") was mailed December 12, 2006 to the new address. Since the Office action had been mailed May 09, 2006, the application is technically abandoned. On January 10, 2007, the petition to which this decision is based was filed. It is to be noted that a paper was filed August 10, 2007 associating the file with a new Customer Number (73066) and changing the address to:

HICKMAN PAPERMO TRUONG & BECKER, LLP/
Yahoo! Inc.
2055 Gateway Place
Suite 550
San Jose, CA 95110-1089

This address is now in the Office PALM records along with the new Customer Number as the correspondence address and is the address to which this decision is mailed.

Discussion

Along with the petition were included several additional papers. One is "Request for Customer Number Data Change" (Form PTO/SB/124A). There is no evidence of when it was filed but is dated December 17, 2004 as to when it was signed by one of applicants' legal representatives, Edward A. Becker (Registration No. 37,777) and includes the address change:

HICKMAN PAPERMO TRUONG & BECKER, LLP/
2055 Gateway Place, Suite 550
San Jose, California 95110

A facsimile transmittal sheet is also included with the Customer Number 29989. It includes a typed date of December 17, 2004 but was corrected by hand to change "17" to -- 22 --. It further includes that it was being sent to the Electronic Business Center of the

U.S. Patent & Trademark Office. There is no Certificate of Facsimile on either paper but Petitioner included a TRANSMISSION VERIFICATION REPO dated December 17, 2004 and a second similar paper but dated December 22, 2004. A copy of an Auto-Reply Facsimile Transmission paper from the Office by facsimile transmission and dated December 17, 2004 is also included in the petition. This paper verifies a Customer Number Data Change for number 29989.

The Auto-Reply Facsimile Transmission paper dated December 17, 2004 is considered evidence that applicants filed a proper change of address that was not entered. For unknown reasons the 37 CFR §1.63 declaration and accompanying transmittal on September 23, 2004 were not associated between the application serial number and the Customer Number. Because of this, it appears the change of address was not timely made by the Office at no fault of the applicants. Subsequently, the examiner's Office action was sent to the wrong address.

MPEP § 707.13 Returned Office Action, states in part:

Office actions are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. **>Upon receipt of the returned Office action, the Technology Center (TC) technical support staff will check the application file record to ensure that the Office action was mailed to the correct correspondence address. If the Office action was not mailed to the correct correspondence address, it should be stamped "remailed" with the remailing date and mailed to the correct correspondence address. The period running against the application begins with the date of remailing.

Decision

The history of the application along with the evidence submitted by Petitioner indicates that the applicants made a timely and proper address change. In view of this and in accordance with MPEP § 707.13, the Office action of record is to be remailed with a new shortened statutory period of three months beginning from the date of remailing of the Office action. The application is being forwarded to the appropriate staff for this remailing. The application is considered not abandoned and is withdrawn from abandonment to the degree it was considered technically abandoned.

PETITION GRANTED.

It is noted that the petitioner included a check in the amount of \$400.00 to cover any fees for the petition though seeking relief under 37 CFR § 1.181. The petition was treated under 37 CFR § 1.181 which does not require a fee. Petitioner may request a refund in accordance with 37 CFR § 1.26. See MPEP 607.02.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

Karen M. Young
Karen M. Young, Director
Technology Center 3700